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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

DAWSON, GLENN K

ART UNIT PAPER NUMBER

3761

DATE MAILED: 10/24/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/985,691

Applicant(s)

PUCKERIDGE, LARRY

Examiner

Glenn K Dawson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 15-74 is/are pending in the application.
- 4a) Of the above claim(s) 53-74 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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***Election/Restrictions***

Claims 53-74 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 4.

Applicant's election with traverse of I in Paper No. 4 is acknowledged. The traversal is on the ground(s) that the withdrawn subject matter is sufficiently related that a search of one group would encompass the other group. This is not found persuasive because it would be burdensome to search for and examine and apply art against the method claims because many of the limitations in the method claims are recited in the apparatus claims in merely a functional way and therefore need not be present to reject the apparatus claims. As presently filed, the application contains 4 additional sets of method claims which are all different in scope. In addition, the present restriction will prevent the applicant from subsequently adding claims to other possible methods of use of the apparatus and therefore prevents divergent paths between the apparatus and method claims. The method claims are not sufficiently tied to the apparatus claims because of the functional language and absence of claim language involving the programming of the control unit to do the claimed specific functions upon activation of the input devices.

The requirement is still deemed proper and is therefore made FINAL.

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### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the CPAP device with air supply system and controller must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 15, 18-30, 32-36 and 43-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Servidio, et al. -5598838.

Servidio discloses a CPAP device having a housing 16, air supply system- 192,250,252,254,150,256,258; a 1<sup>st</sup> input device 29,30,39, a 2<sup>nd</sup> input device 36,37,39 having 1<sup>st</sup> and 2<sup>nd</sup> character displays 28,34,40; and a controller 16. By pushing or actuating the input devices, the CPAP device is movable between various modes of

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operation consistent with applicant's claimed modes- see col.5 lines 5-56. The disclosed device is capable of being used in the claimed manner and many of the claim limitations such as time periods and treatment pressures are deemed to be functional in nature and are met by the fact that the prior art device could be programmed to operate in the claimed manner, lacking claim limitations regarding the controller being programmed to operate in the claimed manner.

Claims 15,18-25,33-36,43,44,49 and 52 are rejected under 35 U.S.C. 102(e) as being anticipated by Woodring, et al.-6543449.

Woodring discloses a CPAP device having a housing A an air supply system 12, 1<sup>st</sup> and 2<sup>nd</sup> input devices 22,160,170,172,174,176,226,228 and associated displays and controller 168,31. By pushing the input devices the device changes the mode of operation-see col. 3 lines 6-16. The disclosed device is capable of being used in the claimed manner and many of the claim limitations such as time periods and treatment pressures are deemed to be functional in nature and are met by the fact that the prior art device could be programmed to operate in the claimed manner, lacking claim limitations regarding the controller being programmed to operate in the claimed manner.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 16,17,37 and 50-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woodring, et al-'449 in view of Anderson-4501937.

Woodring discloses the invention as claimed with the exception of the displays being on the buttons; and the two displays displaying the pressure

Anderson discloses pushbuttons for control circuits with integral displays. It would have been obvious to have employed the use of Anderson's pushbuttons for the mode and setting buttons of Woodring as this would make the device more compact as additional displays would not be necessary or could be much smaller due to the buttons ability to display operating information themselves.

Claims 16,17,31,37-42 and 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Servideo-'838 in view of Anderson-4501937

Servidio discloses the invention as claimed with the exception of the displays being on the buttons; the reference characters being alphabetical characters, the incremental increase/decrease of the pressure, and the two displays displaying the pressure.

Anderson discloses pushbuttons for control circuits with integral displays. The displays may be multi-character alphanumeric displays. It would have been obvious to have employed the use of Anderson's pushbuttons for the mode and setting buttons of Servidio as this would make the device more compact as additional displays would not be necessary or could be much smaller due to the buttons ability to display operating information themselves.


Making the rotary knobs 39 incremental pushbuttons with displays would have been obvious as one skilled in the art would recognize that a rotary increment of a knob and a digital increment by button are well-known alternative expedients.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn K Dawson whose telephone number is 703-308-4304. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 703-308-1957. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

  
Glenn K Dawson  
Primary Examiner  
Art Unit 3761

Gkd  
17 September 2003